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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,580	09/25/2003	Chip Hewette	EI-7602	7454

34769 7590 10/04/2006

NEW MARKET SERVICES CORPORATION
(FORMERLY ETHYL CORPORATION)
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EXAMINER

POULOS, SANDRA K

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/670,580

Applicant(s)

HEWETTE ET AL.

Examiner

Sandra K. Poulos

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 11-41 and 43-45.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

Attachment to Advisory Action

Applicants' amendment filed 9/22/06 has been considered; however, the amendment has not been entered given that it raises other new issues that would require further consideration and/or search.

The new issues were brought about by the introduction of new claims 46-48, drawn to a method for achieving a satisfying score on the ISOT test and L-60-1 test with a lubricating oil substantially free of boron. These method claims were not previously present and would require a new search.

In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

The prior art of rejections of record do not disclose the method for achieving a satisfying score on the ISOT test and L-60-1 test with a lubricating oil, as set forth in claims 46-48.

Applicant's arguments with respect to Waldbillig are not persuasive. Applicant argues that (1) Waldbillig fails to disclose the ratios in claims 11 and 22, particularly because Waldbillig groups together extreme pressure and antiwear additives, and (2) boron is not specifically excluded. With regard to (1), the ratios were calculated and given in the Office action mailed 2/02/06, and fall within the currently claimed ranges. Waldbillig discloses sulfur compounds that are extreme pressure agents and antiwear agents, but does not necessarily teach that there are two distinct groups, but that these

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sulfur compounds act as both extreme pressure agents and antiwear agents, which is consistent with applicant's own specification. Applicant's specification (see pages 13-14) groups together extreme pressure agents and antiwear agents, which is appropriate given that a single compound (particularly sulfur compounds) is disclosed as being able to function as an extreme pressure agent and/or an antiwear agent. The terms "extreme pressure agent" and "antiwear agent" are essentially interchangeable in this regard. Therefore, the ratios are correct. With regard to (2), although the application does not specifically exclude boron, there are no boron containing components disclosed and thus it is clear that it would not contain boron.

Applicant's arguments with respect to Yoshimura are not persuasive. Applicant argues that (1) Yoshimura fails to disclose the ratios in claims 11 and 32, and (2) boron is not specifically excluded.

With regard to (1), the ratio of (i) corrosion inhibitor to dispersant, (ii) dispersant to extreme pressure additive, and (iii) dispersant to antifoam agent are calculated as (using the four endpoints points): (i) 1:50 to 1:10 to 1:1 to 500:1, (ii) 1:50 to 1:2.5 to 1:1 to 20:1, and (iii) 5:1 at the upper end points of both components (see Table on col 10). With regard to (2), the lack of recitation of any boron-containing component is sufficient support to conclude that there is no boron in the composition.

SKP

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